

### **Remarks**

Claims 1 and 68-97 are pending. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested.

### **Applicants Provisionally Elect With Traverse**

In response to the Action requiring species election, Applicants, as the requirement is best understood, provisionally elect with traverse the alleged species "micr character". All independent claims are readable on the elected species. At least all of the independent claims are generic. As the requirement is best understood, all claims are readable on the elected species.

Reconsideration and withdrawal of the election requirement are respectfully requested. As shown in more detail herein, the requirement is without legal basis.

### **The Requirement is not legally proper because there is no serious burden**

MPEP § 803 sets forth criteria for a proper requirement. One of the criteria is that there must be a "serious burden" on the examiner in order for election to be required. Contrarily, if the search and examination of an entire application can be made without serious burden then the examiner must examine it on the merits. Applicants respectfully submit that the election requirement is not legally proper because the criteria for serious burden has not been met.

### **The Requirement is not legally proper as a reasonable number of species are permitted**

Applicants are entitled to a reasonable number of species (i.e., more than one species). Even if it were somehow possible for the Office to show serious burden (which it hasn't), 37 C.F.R. § 1.146 still permits an application to have claims directed to a reasonable number of species. Applicants respectfully submit that even if the application had species as alleged by the Office, the alleged species would still be reasonable, especially in light of the Office's lack of any evidence to the contrary. Again, the requirement is not legally proper and should be withdrawn.

**The Requirement is not legally proper  
because a valid reason for species restriction is absent**

The Office is required to provide on the record a valid explanation as to why the alleged species are independent or distinct. For example, note MPEP § 809.02(a) at Examiner note #2 regarding form paragraph 8.01. Applicants respectfully submit that the election requirement is not legally proper because a valid explanation has not been provided to Applicants. At best, the Action (at page 3, lines 1-2) merely alleges that "The species are independent or distinct because each is can be associated with a distinct document". However, unsupported statements are *not* the requisite legal criteria for establishing a valid species election requirement.

The Action is also silent with regard to any "mutually exclusive characteristics" (MPEP § 806.04(f)) and "relationship" (MPEP § 808.01(a)) of the alleged species. However, in accordance with MPEP § 806.04(f), claims to be restricted to different species must be mutually exclusive. The "general test" as to when claims are restrictable, respectively, to different species is the fact that one claim recites limitations which are found in a first species but not in a second species, while a second claim recites limitations only for the second species and not the first species. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

The Action has not indicated which *claim* recites limitations which are found in a first species but not in a second, while a second *claim* recites limitations disclosed only for the second species and not the first, as is required in order to meet the noted "general test" of MPEP § 806.04(f). Thus, the Action procedurally fails to present a valid reason for the requirement.

Where does the Action demonstrate that the alleged species are mutually exclusive (MPEP § 806.04(f))? For example, where does the Action show that the allegedly different species are prevented from being used in the same embodiment? Where does the Action provide evidence that the other alleged species are specifically prevented from being used with the alleged "micr character" species? Where does the Action provide a reason why the alleged species "micr character" and each of the other alleged species are mutually exclusive species? It doesn't. Likewise, where does the Action provide valid reasons of mutual exclusivity for the other alleged species? The Action has not shown that each alleged species cannot be used in an embodiment with another alleged species. Rather, the Action's own allegations appear to be contrary to the general test for the alleged species being mutually exclusive.

The Action has not met the general test for mutually exclusive species. It follows that the Action also has not met the test for a proper species election requirement. Thus, the requirement is improper and should be withdrawn.

Nor has the Office demonstrated the common characteristic linking each of the alleged species. Applicants respectively disagree with the Actions' allegations and descriptions of species. For these reasons it is respectfully submitted that there is no valid basis for requiring species election. Again, the species election requirement should be withdrawn.

**The Requirement is not legally proper because it is incomplete/unclear**

The species election requirement is unclear. The species restriction requirement does not properly describe the alleged distinct species. Nor are the alleged species clearly and properly presented. Where does the Action correspond each of the alleged species to respective specific claims? It doesn't. The Action leaves Applicants the burden of trying to properly respond to an

unclear and improper requirement. Because the criteria for proper species restriction requirement has not been met by the Office, Applicants have not been given a fair opportunity to make an informed election. On this basis it is respectfully submitted that the requirement should be withdrawn.

The Action does not present a valid species restriction requirement based on the laws, rules, and Patent Office procedures. The Action at best pertains to allegations of species. For these additional reasons it is respectfully submitted that the election requirement is improper.

### **Conclusion**

Applicants respectfully submit that the species election requirement is not legally proper and should be withdrawn. Applicants, as the requirement is best understood, have provisionally elected with traverse. However, Applicants reserve all rights to change or modify their election based on the alleged species election requirement presentation being made a clearly understood and proper requirement.

The undersigned is willing to discuss any aspect of the Application by phone at the Office's convenience.

Respectfully submitted,



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